

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Venkatesh P. )  
Gopinath, et al. ) Group Art Unit: 2812  
                      )  
                      ) Examiner: Stanetta D. Isaac  
Serial No.: 09/991,202      )  
                      ) Atty. Docket No.: 01-555  
Filed: November 21, 2001     )  
                      )  
For: Shallow Trench Isolation Structure    )  
With Low Trench Parasitic Capacitance     )  
                      )

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**RESPONSE TO OFFICIAL ACTION**  
**Restriction/Election Requirement**

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This response is presented to the Office Action mailed August 25, 2004, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group I, method claims 1-26.

**Remarks/Arguments**

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted..." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

In searching the Group I claims, the class and subclass for the Group II claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent

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Number of Pages Including this Page 4

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**MESSAGE:**

US Serial No.: 09/991,202  
Filing Date: November 21, 2001  
Group Art Unit: 2812  
Docket No: 01-555  
Examiner: Stanetta D. Isaac  
Response to Restriction Requirement

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PTO/SB/21 (02-04)

Approved for use through 07/31/2006. OMB 0651-0031

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| <b>TRANSMITTAL<br/>FORM</b><br>(to be used for all correspondence after initial filing) | Application Number   | 09/981,202                    |        |
|   | Filing Date          | November 21, 2001             |        |
|   | First Named Inventor | Venkatesh P. Gopinath, et al. |        |
|   | Art Unit             | 2812                          |        |
|   | Examiner Name        | Stanetta D. Isaac             |        |
| Total Number of Pages in This Submission  | 3                    | Attorney Docket Number        | 01-556 |

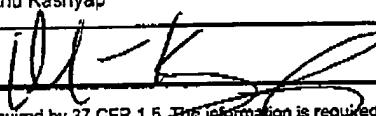
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| <b>Remarks</b><br>Response to Restriction Requirement   |  |  |  |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|                         |   |
|-------------------------|---|
| Firm or Individual name | Timothy R. Croll 36,771 (408) 433-7625  |
| Signature               |  |
| Date                    | September 14, 2004  |

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| Typed or printed name | Manu Kashyap  |
| Signature             |  |
|                       | Date 09/14/2004   |

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